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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,509	04/05/2001	John Hindman	ODS-37	6107
1473	7590	03/16/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			COBURN, CORBETT B	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/827,509

Applicant(s)

HINDMAN ET AL.

Examiner

Corbett B. Coburn

Art Unit

3714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-31.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) _____.
13. ☒ Other: See attached.

CORBETT B. COBURN
PRIMARY EXAMINER

Corbett B. Coburn
Primary Examiner
Art Unit: 3714

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10 February 2006 have been fully considered but they are not persuasive.
2. Applicant argues that Gordon fails to teach use proposed bets. Applicant states that Gordon speaks in terms of "bets" and wagers "placed" on horses. Further Applicant argues that Examiner has failed to provide a basis in fact or technical reasoning to support the conclusion that Gordon is inherently capable of processing proposed bets to provide the projected effect of those proposed bets on the odds.
3. As Examiner has repeatedly pointed out, Gordon does not say that any money changes hand prior to making changes to the indicated odds. It is, and has always been, Examiner's position that until money actually changes hand, all "bets" are "proposed bets". Furthermore, Gordon makes it clear that the device can subtract out the amount "bet". In the racing art, it is understood that only proposed bets may be subtracted – finalized bets are never subtracted. Once a bettor pays his money through the window, he cannot get the money back. All "bets" are final. The fact that Gordon's "bets" may be subtracted from the pool indicates that Gordon's "bets" may be "proposed bets".
4. Examiner contends that this line of reasoning provides ample support for his contention that Gordon does in fact teach "proposed bets" and provides a basis in fact and technical reasoning to support the conclusion that Gordon is inherently capable of processing proposed bets to provide the projected effect of those proposed bets on the odds.

Art Unit: 3714

5. Examiner agreed with Applicant's telephonic argument that the method cannot be rejected merely because the device has the inherent ability to perform a particular function. (An argument that does not, however, appear on the record.) Clearly, Gordon's device has the inherent ability to perform the functions claimed in the canceled apparatus claims, but this does not necessarily mean that Gordon teaches the method -- just because popcorn can be poured through an oil funnel doesn't mean that an oil funnel reference teaches a method of pouring popcorn.

6. Examiner has given Applicant's arguments a great deal of thought. Examiner has tried to read Gordon in the Applicant's favor. But Examiner cannot get over the fact that Gordon discloses, "Reversal of the motors (114, 99 & 115) by actuation of relay (116) permits deductions [from the displayed total bets and the calculated odds] to be made." (Page 5, Col 1, 2-5) Examiner notes that the embodiment being described is not a general calculator meant for use in non-racing applications because four lines down, the disclosure states that this allows the system to indicate the various totals or odds at any instant. These deductions can only make sense if Gordon contemplates "proposed bets".

7. Furthermore, Gordon teaches that, "devices of the type described above are capable of automatic operation to add, subtract (emphasis added), divide or multiply and that a simple construction has been provided which is suitable for pari-mutuel betting." (Page 6, Col 1, 53-58) This subtraction ability is useful only if the "bets" are "proposed bets".

8. Examiner admits that this is a difficult matter. Gordon clearly has the ability to function with finalized bets. As Applicant points out, the disclosure speaks in terms of "bets" and wagers "placed". It is only through inference that Examiner arrives at the conclusion that Gordon

Art Unit: 3714

contemplates proposed bets too. But as Examiner has pointed out, Gordon teaches that the amount “bet” may be subtracted from the totals and removed from the odds calculated. This is not done with finalized bets. Thus Examiner must conclude that Gordon teaches proposed bets.

9. Would one of ordinary skill in the art understand Gordon to teach proposed bets?

10. As noted above, those skilled in the horse racing art understand that once money changes hands, bets are finalized – they cannot be undone. Therefore, those skilled in the art would realize that a disclosure of subtracting bets means that the system is intended to function with proposed bets – i.e., bets that are not finalized. (This is not to say that the system does not work with finalized bets. It means that the system contemplates working with both proposed bets and finalized bets.) Furthermore, they also understand that large bets can have significant effects on the odds in any pari-mutuel gambling system. This is so well known that the fact has found its way into works of fiction. (See, for instance, *Diamonds Are Forever*, Ian Fleming, 1956.) This makes the ability to add in proposed bets (and later subtract them if they are not finalized by paying money through the window) a highly useful feature and a fairly obvious one. One of ordinary skill in the art would have readily grasped the importance of Gordon’s bet subtraction capability and have applied it to the problem of calculating and displaying the projected effect on odds of relatively large wagers.

11. Given the level of knowledge in the art, Examiner believes that one of ordinary skill in the art would have seen Gordon (in combination with the other applied art) as teaching the claimed method.

Art Unit: 3714

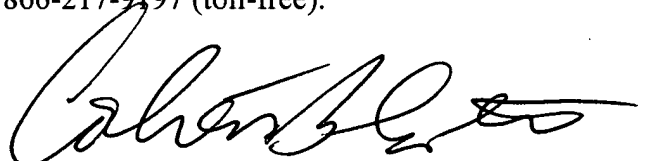
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Jones can be reached on (571) 272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Corbett B. Coburn
Primary Examiner
Art Unit 3714

**CORBETT B. COBURN
PRIMARY EXAMINER**